

ATTORNEY DOCKET NO. HKPC/360/US

REMARKS

No claims have been cancelled. Claims 1 and 5 have been amended. Applicants note that the claims as amended are fully supported by the application as filed. For example, the Applicants respectfully direct the Examiner's attention to the specification at page 7, lines 8-10 (water inside the boiler is always maintained at an optimal temperature so that the machine is readily available to make hot drinks anytime); Figure 5; and Figure 10. Upon entry of the above amendments and following remarks claims 1-16 will be pending in the present application.

Information Disclosure Statement

Applicants are filing an IDS with this paper. The IDS references a European Search Report for a corresponding European application. Applicants assert that none of the references cited in the European Search Report are more relevant than those references previously cited in the present application.

The European Search Report cites International Application Number PCT/US02/08282 as a category "X" document with respect to claims 1-3, 6-8, 10, 12-14, and 16. International Application Number PCT/US02/08282 fails to disclose at least a heating element having a liquid storage portion configured to heat a volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time as found in amended claim 1. In addition, the present claimed invention is non-obvious in view of International Application Number PCT/US02/08282 and/or any of the references cited in the present application under a proper 35 U.S.C. §103 analysis.

Allowable Claims

Claim 5 has been considered to be allowable "if rewritten in independent form including all of the limitations of the base claim and any intervening claims".

Applicants have rewritten claim 5 into independent form as suggested by the Examiner. As such, claim 5 should now be allowed.

Claims 1-4 and 6-16 Are Non-Obvious Under a Proper 35 U.S.C. §103 Analysis

Claims 1-3, 6, 8-10, 12-14, and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Klawuhn et al. in view of Van Der Meer. The Examiner has asserted that Klawuhn discloses the inventive apparatus with the exception of a microprocessor. The Examiner further asserts that “[I]t would have been obvious to one of skill in the art to provide the system of Klawuhn with the microprocessor disclosed in Van Der Meer, in order to provide an automatic control of the device based upon preset user preferences”. Claim 14 has been specifically rejected wherein it is asserted that “the brewing of tea is an intentional use”. Claim 16 has been specifically rejected wherein the Examiner asserts that Klawuhn teaches that “various types of pumps can be used”.

Claim 4 has been rejected based on the combination of Klawuhn and Van Der Meer in further view of U.S. Patent No. 6,279,460 to Pope. Claim 7 has been rejected based on the combination of Klawuhn and Van Der Meer in further view of U.S. Patent No. 6,474,221 to Shaanan et al. Claims 11 and 15 have been rejected based on the combination of Klawuhn and Van Der Meer in further view of U.S. Patent No. 4,725,714 to Naya et al.

All Claimed Elements Not Present in Combination of Klawuhn and Van Der Meer

The courts have long established that “when even one claimed limitation is not found in the combination of prior art, a rejection under 35 U.S.C. §103 is improper”. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)..

The combination of Klawuhn and Van Der Meer clearly fails to disclose at least a heating element having a liquid storage portion configured to heat a

volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time as found in amended claim 1. In contrast both Klawuhn and Van Der Meer disclose low mass flow-through heater assemblies. The Klawuhn and Van Der Meer heaters are designed to be associated with an exterior portion of the liquid conduit. See Klawuhn at column 3, lines and Van Der Meer at column 1, lines 40-42. This flow-through configuration clearly does not teach or suggest a heating element having a liquid storage portion configured to heat a volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time. Claims 1-4 and 6-16 depend either directly or indirectly on amended claim 1 and are patentable for at least the reasons stated above.

Rejection of Claim 9 is Improper

The rejection of claim 9 is additionally improper for at least the additional reason that both Klawuhn and Van Der Meer fail to teach or suggest a shower plate for dispensing water into the brewing chamber. In contrast, both Klawuhn and Van Der Meer teach or suggest a pipe 9 (Klawuhn) or a tube (Van Der Meer Figure 1) for supplying water to a brewing chamber. Claim 9 is patentable for at least this additional reason.

Rejection of Claim 12 is Improper

The rejection of claim 12 is additionally improper for at least the additional reason that both Klawuhn and Van Der Meer fail to teach or suggest a heating element having a liquid contact interface that is substantially stainless steel. In contrast, Klawuhn and Van Der Meer teach or suggest a heating element disposed on the outside surface (emphasis added) of a water conduit. See Klawuhn column 3, lines 50-52; Van Der Meer column 1, lines 40-41. Claim 12 is patentable for at least this additional reason.

Rejection of Claim 16 is Improper

The rejection of claim 16 is additionally improper for at least the additional reason that both Klawuhn and Van Der Meer fail to teach or suggest a pump having a magnetic coupling between a drive motor and an impeller. The Examiner has stated that Klawuhn, at column 6, lines 59-63, teaches or suggests such a pump. This statement appears to be entirely misplaced. Klawuhn, at column 6, lines 59-63, simply does not disclose a pump having a magnetic coupling between a drive motor and an impeller. Applicant respectfully reminds the Examiner that the burden is on the Examiner to demonstrate that the prior art evidences sufficient suggestion of the desirability of doing what the inventor has done. See M.P.E.P. §2142. At an irreducible minimum, this burden requires this Examiner to apply the facts of the case to "present a convincing line of reasoning

as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Clearly, the Examiner "cannot discharge himself from this burden by simply declaring all of the elements of an invention, along with the manner of combining these elements, to be well known in the art." Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989). As such, the rejection of claim 16 is improper.

No Motivation or Suggestion to Combine the Teachings of Klawuhn and Van Der Meer

It is a well-established "general rule" that references that teach away cannot serve to create a *prima facie* case of obviousness. In re Gurley, 27 F3d 551, 553, 31 USPQ2d 1131, 1132 (Fed. Cir. 1994). "There is no suggestion to combine, however, if a reference teaches away from its combination with another source. See id. at 1075, 5 USPQ2d at 1599." A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant..." Tec Air, Inc. v. Denso, 192 F.3d 1353, 52 USPQ2d 1297 (Fed Cir. 1999).

In properly taking Klawuhn and Van Der Meer as a whole, the two references do not support the asserted obviousness rejection for at least the reason that the references teach away from the combination or modification asserted. Klawuhn clearly teaches a heater for heating liquid which is a low mass flow-through heater. In addition, the Klawuhn and Van Der Meer heaters are designed to attach to an outside portion of the liquid conduit. See Klawuhn at column 3, lines and Van Der Meer at column 1, lines 40-42. Clearly a person of ordinary skill, upon reading Klawuhn and Van Der Meer would be led in a direction divergent from the path that was taken by the Applicant. The flow-

through heater of each Klawuhn and Van Der Meer clearly suggests a "line of development flowing from the reference's disclosure unlikely to be productive of the result sought by the applicant " of providing a heating element having a liquid storage portion configured to heat a volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time and therefore teaches away.

Rejection Improper Since Substantial Reconstruction and Redesign of Reference

The rejection is also improper since the modification of Klawuhn with the disclosure of Van Der Meer to provide a heating element having a liquid storage portion configured to heat a volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time would require a substantial reconstruction and redesign as well as a change in the basic principles under which the Klawuhn construction was designed to operate. This has long been established to preclude a rejection under 35 U.S.C 103. In re Ratti, 270 F2d 810, 123 USPQ 349 (CCPA 1959). Klawuhn clearly relies on the a "uniform throughflow and heating of water in the water conduit of the flow-through heater". Klawuhn column 3, lines 50-52. Modification of the Primary reference of Klawuhn to provide a heating element having a liquid storage portion configured to heat a volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time can clearly be seen to defeat this principle without substantial reconstruction or redesign and therefore the rejection must be withdrawn.

Applicant notes that the holdings with regard to "bodily incorporation" in the case of In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981), "physically combinable" in the case of In re Sneed, 710 F2d 1544, 1550, 218 USPQ 385, 389 (Fed. Cir. 1983), and "ability to combine their specific structures" in the case of In re Nievelt, 482 F2d 965, 179 USPQ 224, 226 (CCPA 1973) do not apply since Applicant is clearly arguing that the asserted combination of

“Klawuhn et al. in view of Van Der Meer” changes the principle of operation as contained in the teaching of Klawuhn and is not suggesting that the reference features be bodily incorporated, or physically combined.

No Expectation of Success For the Proposed Modification or Combination

The courts have held that for obviousness under 35 U.S.C. § 103, there must have been a reasonable expectation of success for the modification proposed by the examiner. In re O’Farrell, 853 F.2d 894, 903-904, 7 USPQ2d 1673, 1680-1681 (Fed. Cir. 1988). The expectation of success is not whether it would have been obvious to try a modification or combination. Gillette Co. v. S.C. Johnson & Son, Inc., 9191 F.2d 720, 725 (Fed. Cir. 1990).

The combination asserted of “Klawuhn et al. in view of Van Der Meer” finds no expectation of success since one skilled in the art would recognize that the combination or their teachings would not successfully result in the claimed invention. Since not only would a beverage brewer having a heating element having a liquid storage portion configured to heat a volume of liquid to a desired temperature and to store the heated volume of liquid for a desired period of time not result, but the operative principle of both Klawuhn and Van Der Meer would need to be modified in a manner inconsistent with their teaching or suggestion. A rejection under 35 U.S.C. §103 has not been properly made for at least this reason.

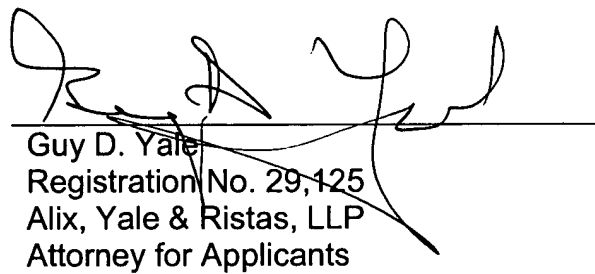
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In summary, the Applicants have addressed each of the rejections within the present Office Action. It is believed the application now stands in condition for allowance and prompt favorable action thereon is earnestly solicited.

Respectfully Submitted,

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